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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/172,830	10/15/1998	ALAIN ZANCO	2348-348/2.R493.42	9826

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 11/29/2001

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/172,830

Applicant(s)

ZANCO, ALAIN

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 7,10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the term and/or phrase "interlocking surface **means**" do not appear in the specification.

Claim Rejections - 35 USC § 112

Claims 1-3,5,8,9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "interlocking surface means" is unclear and indefinite since it is not clear if applicant is trying to invoke 112, 6th paragraph.

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for " or "step for ";
- (B) the "means for " or "step for " must be modified by functional language; and
- (C) the phrase "means for " or "step for " must not be modified by structure, material or acts for achieving the specified function. Applicant fails to have the first two steps of the 3-prong analysis.

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Moreover, applicant's specification does not adequately describe the corresponding structure, material, or acts necessary to support a claim limitation which invokes 35 USC 112, sixth paragraph and therefore it is unclear what structure such language encompasses.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1,2,8 is/are rejected under 35 U.S.C. 102(e) as being anticipated by 4674202 (*Bourque*).

Bourque teaches a boot having structure substantially as claimed including the sole have a first rigid part (the first half of the sole is rigid because of element 10 which is rigid in areas 14 and 16) and the rest of the sole is flexible. The front half of the rigid part (10) has grooves (28) that permit the front half of the sole to be flexible. The sole of *Bourque* has a profiled part (the cutout as shown in the rear of sole in figure 2). This profiled part is inherently capable as functioning as an interlocking surface as claimed.

3. Claims 1-3 is/are rejected under 35 U.S.C. 102(e) as being anticipated by US 4246708 (*Gladek*).

Gladek teaches a boot having structure substantially as claimed including the sole have a first rigid part in the rear region that encloses the heel and the rest of the sole being flexible. The front half of the sole is flexible due to the apertures (10) that permit the front half of the sole to flex. The outer surface of the rigid sole part is inherently capable as functioning as an interlocking surface inasmuch as a binding is capable of lacking on to this surface.

4. Claims 1-3,9 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *US 5884420 (Donnadieu)*.

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3) in the rear region that encloses the heel and the rest of the sole (15) being flexible. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" *Ex parte Masham* 2 USPQ2nd 1647. Also see *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA

1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The outer surface of the rigid sole part serves as the interlocking surface.

5. Claims 1-3,9 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *US 5899006 (Donnadieu)*.

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3,8) in the rear region that encloses the heel and the rest of the sole (2) being flexible. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" *Ex parte Masham* 2 USPQ2nd 1647. Also see *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The outer surface of the rigid sole part serves as the interlocking surface.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 8 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over either [Donnadieu '006 or '420 or Gladek] in view of Bourque '202 and US 4186500 (Salzman).

Donnadieu and Gladek all teach a boot (cross-country boots) substantially as claimed except for a cutout/profile part in the rigid sole part of the boot. Bourque and Salzman both teach cross-country boots have a rear cutout portion (or a profile part). It would have been obvious to provide the boot of either Donnadieu or Gladek with a cutout portion, as taught by Bourque and Salzman, to provide reinforcement to the sole of the boot and to facilitate securing to a binding.

8. Claims 3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque '202 in view of Donnadieu or Gladek.

Bourque teaches a boot substantially as claimed (see the rejection above for details) except for a rear part rigidly enclosing the heel. Donnadieu and Gladek both teach providing a boot with the sole having an integral rigid heel part. It would have been obvious to one of ordinary skill in the art to provide the boot as taught by Bourque

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with the sole having a rigid part enclosing the heel, as taught by either Donnadieu or Gladek, to prevent twisting in the rear part of the boot.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-3,5,8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,173,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same essential features such as a boot having rigid and flexible portions and an interface (interlocking surface).

Response to Arguments

11. Applicant's arguments filed 11-7-01 have been fully considered but they are not persuasive.

Applicant argues that "Bourque does not provide...a sole having a rigid part with an interlocking surface means for interlocking with a binding".

It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

Applicant argues that Donnadieu doesn't teach applicant claimed invention, which now recites the interlocking surface in a means plus function format.

To the contrary, applicant doesn't correctly use the means plus function format. Moreover, it is not clear what structure would encompass such language since the specification lacks proper antecedent basis for such language. It would appear the reference used in the rejection above have structure that are inherently capable of performing such language.

12. Applicant's arguments with respect to claim 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

14. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (**FORMAL FAXES ONLY**). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also

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use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
November 15, 2001